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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,809	06/20/2003	Keith C. Hong	183-01	9261
27569	7590	01/19/2006	EXAMINER	
PAUL AND PAUL 2000 MARKET STREET SUITE 2900 PHILADELPHIA, PA 19103			TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/600,809

Applicant(s)

HONG ET AL.

Examiner

Elena Tsoy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.  
4a) Of the above claim(s) 19-38 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/04/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### ***Response to Amendment***

Amendment filed on 12/02/2005 has been entered. Claims 1-38 are pending in the application.

### **Election/Restrictions**

Applicant's election with traverse of Group I, claims 1-18 in the reply filed on 12/02/2005 is acknowledged. The traversal is on the ground(s) that the proposed use is on its face not a *specific* use. This is not found persuasive because according to MPEP § 806.05(h)), for the inventions to be shown to be distinct, there is no requirement of showing the *specific* use. Since the use of the product in NON-roofing outdoor surfacing is a process that is materially different from the roofing surfacing, as required by MPEP § 806.05(h)), the inventions are distinct.

The requirement is still deemed proper and is therefore made FINAL.

### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Objection to claim 16 under 37 CFR 1.75 as being a substantial duplicate of claim 7 has been withdrawn due to amendment.
3. Claim 17 stands objected to under 37 CFR 1.75 as being a substantial duplicate of claim 8.
4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 1762

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-8, 16-17 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-12, 21, 25 of copending Application No. 10/600,847 for the reasons of record set forth in paragraph 4 of the Office Action mailed on 8/10/2005.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5-8, 13, 14, 16, 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by Joedicke (US 6,214,466) for the reasons of record set forth in paragraph 6 of the Office Action mailed on 8/10/2005.

7. Claims 1, 5-8, 16, 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by Skadulis (US 3,528,842) for the reasons of record set forth in paragraph 7 of the Office Action mailed on 8/10/2005.

8. Claims 1, 5-8, 16, 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by McMahon (US 3,507,676) for the reasons of record set forth in paragraph 8 of the Office Action mailed on 8/10/2005.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-4, 15, 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Joedicke/Skadulis/McMahon in view of Jungk (US 4,946,505) for the reasons of record set forth in paragraph 10 of the Office Action mailed on 8/10/2005.

11. Claims 9-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Joedicke/Skadulis in view of Jungk, further in view of Ryan et al (US 6306795) for the reasons of record set forth in paragraph 11 of the Office Action mailed on 8/10/2005.

12. Claims 13-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Skadulis for the reasons of record set forth in paragraph 12 of the Office Action mailed on 8/10/2005.

***Response to Arguments***

13. Applicants' arguments filed 11/14/2005 have been fully considered but they are not persuasive.

(A) Applicants argue that the provisional double patenting rejection should be withdrawn because the respective applications claims are drawn to distinct inventions, as can be seen from simple inspection of their independent claims, and the disclosures of the two applications are not the same.

The Examiner respectfully disagrees with this argument. In contrast to Applicants argument, the respective applications claims are not distinct inventions because claims of current application are **broad**er than those of copending Application No. 10/600,847 so that the subject matter claimed in the instant application is **fully** disclosed in the referenced copending application and would be covered by any patent granted on that copending application.

(B) Applicants argue that the mineral aggregates employed by Joedicke are "natural base rocks such as greenstone, rhyolite, andesite, basalt, nepheline syanite, and the like" (col. 4, lines 15-19). Thus, Joedicke does not employ *porous* mineral aggregate. The disclosed mineral aggregates are not explicitly known to be porous, and there is nothing to suggest any are inherently porous.

In contrast to Applicants statement, it is well known that the disclosed "natural base rocks such as greenstone, rhyolite, andesite, basalt, nepheline syanite, and the like" are porous *inherently*. For example, it is well known that even the *relatively non-porous* rocks have a *substantial porosity*, as evidenced by US 2,981,636 (See column 3, lines 8-18) to Lodge et al **submitted by Applicants with IDS of 1/23/2004**.

(C) Applicants argue that the mineral aggregates such as greystone or nepheline syenite granules of Skadulis or McMahon are not porous, inert base particles.

The Examiner respectfully disagrees with this argument for the reasons set forth in (B) above.

(D) Applicants argue that a combination of references Joedicke/Skadulis/McMahon in view of Jungk does not establish a *prima facie* case of obviousness. Even if one of ordinary skill in the art were to follow the combined teachings of the cited references, she would not arrive at the process of the presently claimed invention. Further, there is no suggestion or motivation in any of

Art Unit: 1762

the cited references nor in any combination of the cited references that would induce one of ordinary skill in the art to combine their teachings in the manner suggested by the Examiner.

The Examiner respectfully disagrees with this argument. It is well known in the art that dusty mineral powders formed during crushing and sieving can be re-used by granulating the dusty powders. Jungk is a secondary reference which is relied upon to show that dusty powders can be granulated by means of conventional rotating **pelletizing** drum or plate.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used stone dust in Joedicke/Skadulis/McMahon by first granulating the dusty stone by means of conventional rotating pelletizing drum or plate and an aqueous solution of a binder, as taught by Jungk since it is well known in the art that dusty mineral powders formed during crushing and sieving can be re-used by granulating the dusty powders.

(E) Applicants argue that a combination of references Joedicke/Skadulis/McMahon in view of Jungk, further in view of Ryan et al does not establish a *prima facie* case of obviousness because Ryan is not properly combinable with Joedicke or Skadulis because Ryan relates to a non-analogous art, the preparation of chemical catalysts.

In response to applicant's argument that Ryan et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Ryan et al teach that cuprous oxide can be incorporated into a *porous* carrier material such as silica/alumina (See column 10, lines 27-28) by impregnating the porous carrier material with an aqueous solution of copper salts such as copper nitrate using e.g. well known the pore-volume impregnation (PVI) method (See column 11, lines 4-7, 22-42, 50-

Art Unit: 1762

67), air drying and calcining the impregnated porous carrier material at 200 °C-540 °C to convert the copper salt to cupric oxide, cuprous oxide, or a mixture of the two (See column 12, lines 1-22).

Therefore, in this case, Ryan et al is reasonably pertinent to the particular problem with which the applicant was concerned, namely how to incorporate cuprous oxide into a porous carrier material.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**ELENA TSOY**  
**PRIMARY EXAMINER**



Elena Tsoy  
Primary Examiner  
Art Unit 1762

January 10, 2006